

REMARKS

Claims 1-5 are all the claims pending in the application.

I. Response to Obviousness-type Double Patenting Rejection

Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-6 of copending application no. 10/768,674; claims 1 and 6-8 of co-pending application no. 10/934,727; and claims 1-9 of copending application no. 10/757,512.

Applicants do not acquiesce in the merits of the rejection.

In addition, with respect to copending application nos. 10/768,674 and 10/934,727, it is submitted that MPEP 804.I.B. states that if the Examiner has issued a provisional double patenting rejection between two co-pending applications and the only rejection remaining in one application prior to issuing a Notice of Allowance is the provisional double patenting rejection, the Examiner should withdraw that rejection and permit the application to issue as the patent. *See* MPEP 804.I.B. Then, the "provisional" double patenting rejection in the other application (i.e., Application No. 10/221,447) is converted into a double patenting rejection at the time the present application issues as a patent.

Thus, Applicants respectfully request that the Examiner withdraw the provisional double patenting rejection in this application, and issue a double patenting rejection in the co-application.

Further, with respect to copending application no. 10/757,512, to advance prosecution, Applicants submit herewith a terminal disclaimer to disclaim the terminal part of any patent granted on this application which would extend beyond the expiration of the full statutory term

of any patent granted on co-pending application 10/757,512. In addition, Applicants submit that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection.

In view of the above, withdrawal of the obviousness-type double patenting rejections is respectfully requested.

II. Response to Rejection of Claims 1-5 under 35 U.S.C. § 102(b)

Claims 1-5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Saito et al. (US 5,093,214).

Applicants respectfully traverse the rejection.

It is respectfully submitted that Saito does not disclose, teach or suggest the present invention.

To support an obviousness rejection, there must be some teaching or suggestion in the prior art, and a mere teaching by itself is not sufficient to provide motivation for one skilled in the art to arrive at the claimed invention. In this case, Saito only discloses specific examples of polycarbodiimide resins comprising a single type of repeating unit. *See* cols. 2-3. Indeed, there is no disclosure in Saito with respect to any relationship between repeating units. Thus, Saito does not provide any motivation that would lead one of ordinary skill in the art to prepare a polycarbodiimide having the structure of the present invention with the claimed relationship between formula (1) and (2).

In addition, none of the Examples of Saito are directed to polycarbodiimide resins where two different types of organic diisocyanates (e.g., naphthalene diisocyanate and another type of diisocyanate) were used. Therefore, Saito would not lead one of ordinary skill in the art to

specifically select naphthalene diisocyanate and react it with another type of diisocyanate based on the broad disclosure of Saito that various "organic diisocyanates" can be used. Accordingly, Saito does not provide any motivation for selecting naphthalene diisocyanate from the various organic diisocyanates, reacting it with another type of diisocyanate, and using 5 mol% or more of naphthalene diisocyanate based on the total organic isocyanate.

Further, as argued in the previous response, Saito relates to a fuel cell separator and the thin carbon plate for use as the fuel cell separator is obtained by forming a polycarbodiimide resin into a thin plate and heating and carbonizing the thin plate, which is quite apparent from the claims of Saito. In other words, because the polycarbodiimide used in the invention of Saito is heated and carbonized, it is not transparent.

On the other hand, the present invention relates to a polycarbodiimide resin having a high index of refraction, which is for optical use. Accordingly, different from the polycarbodiimide of Saito, which is heated and carbonized, the polycarbodiimide of the present invention is required to have transparency and actually has transparency. The polycarbodiimide resin that has transparency and is suitable for optical use can be obtained by the composition as defined in claim 1, especially by utilizing the production process as defined in claim 5. Specifically, transparency is provided based on the carbodiimide unit having a naphthalene group and a high index of refraction is provided based on the carbodiimide unit having another organic diisocyanate residue.

As described above, Saito does not disclose or suggest a transparent polycarbodiimide resin which is suitable for optical use. Moreover, Saito is silent with respect to a high index of refraction.

Therefore, it is respectfully submitted that Saito does not disclose or suggest the present invention.

In the Office Action, the Examiner also notes that although the naphthalene diisocyanate percent content of claim 5 is not fully equivalent to the ratio of m to n within claim 1, given that n designates the non-naphthalene diisocyanate residue of claim 1, the ratio of claim 1 specifies a percent content for naphthalene diisocyanate residue of 1 % to 95%.

The amount defined in claim 5 is the ratio of components during the production process. Based on the reactivity of each isocyanate, the amounts of isocyanates are not necessarily reflected into the amounts of constituents in the resulting copolymer. Claim 1 recites the ratio of respective units in the copolymer while claim 5 recites the ratio of components in the production process. Thus, it is respectfully submitted that there is no inconsistency between claim 1 and claim 5.

In view of the above, it is respectfully submitted that the present invention is neither disclose nor suggested by Saito. Accordingly, withdrawal of the rejection is respectfully requested.

III. Conclusion

For the above reasons, reconsideration and allowance of claims 1-5 is respectfully requested.

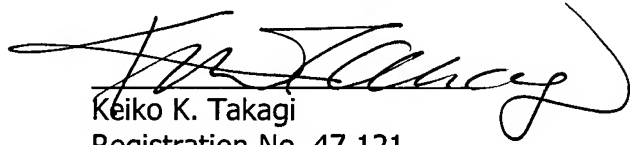
If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No.: 10/773,296

Attorney Docket No.: Q79398

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Respectfully submitted,



Keiko K. Takagi
Registration No. 47,121

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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